

#9/Response
Hawkins

OPT 32U

5-9-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Smalser, et al Exam : Gonzalez, J.
Serial No. : 09/429,419 A.U. : 2834
Filed : 10/28/99
For : PROTECTION ARRANGEMENT . . GENERATION
SYSTEMS

PRELIMINARY RESPONSE TO FINAL REJECTION

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

This is a preliminary response to the final rejection mailed 03/28/02.


With respect, it appears that the finality of the rejection is premature and that such finality should be withdrawn. While the present response is not a full response to the pending action, it is submitted that this partial response is appropriate in view of the significant procedural problems raised by the issuance of a final rejection. How applicant considers the rejection and how applicant might respond thereto, e.g., by presenting new claims to previously unclaimed subject matter, is directly affected by whether or not the pending action is final.

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703)305-1341) on May 1, 2002.

Catherine M. Urglavitch

(Type or print name of person faxing paper)

Date: 5/1/02

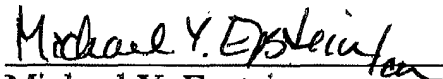
(Signature of person faxing paper)

The Examiner justifies the finality of the rejection by explaining that applicant's "amendment necessitated the new ground(s) of rejection" With respect, this is not quite correct. As clearly noted in the top paragraph on page 5 of applicant's amendment (filed Jan. 18, 2002), pending claim 9 corresponds exactly to the combination of former claims 1 and 3; claim 12 corresponds, without change, to former claims 2 and 6; and claims 10, 11, 13 and 14 correspond, without change, to former claims 4, 5, 7 and 8, respectively. Thus, concerning claims 9 - 14, no changes were made from former claims 3 - 8, and the present rejections of claims 9 - 14, for reasons other than the prior rejections of claims 3 - 8, raise new issues not necessitated by applicant's amendment. The Examiner appears to have overlooked the text in the MPEP, at the bottom of the right-hand column of page 700-57, that an action should not be made final for a rejection on newly cited prior art of any claim not amended even if other claims are amended.

Withdrawal of the finality of the pending Office action is requested. Should this be done, a re-dating of the effective date of the action is also requested.

A prompt response is requested.

Respectfully submitted,



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